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Gabrio Roncucci

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WOLF GREENFIELD & SACKS, P.C.
600 ATLANTIC AVENUE
BOSTON, MA 02210-2206

EXAMINER

WARD, PAUL V

ART UNIT

PAPER NUMBER

1624

MAIL DATE

DELIVERY MODE

11/27/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Election/Restrictions

STATUS OF THE CLAIMS: Claims 1-2, 4-10, 15-16 and 19-26 are pending in this application.

Group III has been further restricted. Applicant is expected to respond to each and every ground of rejection set forth herein below.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- IIIa. The compounds, composition, process and method of treating according to claims 1-2, 4-5, 7-8, 10, 19-20 and 23-26.
- IIIb. The conjugates of compounds according to claim 6.
- IIIc. The intermediate compounds in the preparation of compounds according to claim 9.

The inventions of Groups IIIa-c are separate and patentably distinct because there is no patentable co-action among them and a reference anticipating or rendering obvious one member will not anticipate or render another obvious.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and different classification, a search of the three groups designated above would impose an undue burden upon the examiner, and restriction for examination purposes as indicated is proper.

The inventions listed as Groups IIIa-IIIc do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

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corresponding special technical features for the following reasons: Group IIIa is drawn to a compound, its composition, method of preparing and diagnostic agent. Group IIIb is a different compound which are conjugates of compounds with respect to the compounds of Group IIIa. Group IIIc, is drawn to intermediate compounds, Therefore, there is no special technical feature for the compounds or different fields of application of the compounds. Additionally, there is no unity of invention.

There is no special technical feature, which unites the groups. But even if there were a special technical feature there must be unity of invention also. Under 37 CFR 1.475:

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product;
or
- (2) A product and a process of use of said product; or

(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or

(4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

The above groups 1-2 together do not meet the requirement of unity of invention as given above in (1) -(5).

A telephone call was made to Michael J. Pomianek on September 3, 2008 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Michael Pomjanek on November 21, 2009 to request an oral election to the above restriction requirement, but did not result in an election being made.

Allowable Subject Matter

Claims 1-2, 4-5, 10 and 25-26 contain the following language (at the end of the claim): "wherein the compounds are effective for the treatment of at least one of: infectious diseases of viral, fungine, and bacterial...upon irradiation with light of

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appropriate wavelength." It is not understood if this is a limitation or not, and intended use claims do not have patentability weight, and thus, will be rejected under 35 USC 112. However, if this language is deleted from the claims, the claims will be allow. Additionally, for claim 10, Examiner suggests amending claim to read (for example) "A pharmaceutical composition comprising the compound of claim 1 and a pharmaceutically acceptable carrier." The compounds in Claims 1-2, 4-5, 10 and 25-26 were not found to be obvious nor anticipated by the prior art of record. Thus, the prior art does not teach or suggest the presently claimed compounds. Therefore, these claims will be allowed if amended to overcome a rejection under 35 USC 112.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL V WARD whose telephone number is 571-272-2909. The examiner can normally be reached on M-F 8 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0642. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**/PAUL V WARD/
Examiner, Art Unit 1624**